

REMARKS

The Office Action mailed August 28, 2006 issued a restriction requirement, alleging that the application contains inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The restriction requirement requires the Applicant to elect a single invention. The restriction requirement further requires the Applicant to elect a completely defined single general formula I-XI defined by that group, i.e. ring substituents namely "R₁", "R₂", "R₃", "X", "Y", "Z", "L", "M" and "N" encompassed by the general formula of the elected group must be defined specifically.

In response, Applicant has elected Group V, claims 90-91, 53-58, 72-75, drawn to a medium or kit comprising the medium for separating at least one ATP binding protein from a pool of proteins, the medium comprising at least one compound of the general formula V, **with traverse**. Applicant has further elected Compound G as a completely defined single general formula defined by the group V, i.e., substituent A is selected to be -O-, X_a is selected to be -NH-, Y is selected to be -NH₂-, Z is selected from -SO₂-NR₁-, -CO-, -O-CO-, -NH-CO-, -COO-, -CO-NH-, -CS-NH-, -OCH₂-, -SCH₂-, or -NH-CO-NH-, and each l is selected to be 0, each m is selected to be 0, each n independently is selected to be an integer 3, each o is selected to be 0, each p is selected to be 0, each R₁ is independently selected from C₁ alkoxy, an unsubstituted or partially or fully substituted aryl, wherein the aryl are optionally substituted by -F, -Cl, with traverse. All claims read on the elected species. It is believed that no new matter is added by way of the amendments made to the claims or specification or otherwise to the application.

According to the WIPO Guidelines for Examination, Chapter III, section 7, the following rules are found:

"Rule 30(1) indicates how one determines whether or not the requirement of Art. 82 is fulfilled when more than one invention appears to be present. The link between the inventions required by Art. 82 must be a technical relationship which finds expression in the claims in terms of the same or corresponding special technical features. The expression "special technical features" means, in any one claim, the particular technical feature or features that define a

contribution that the claimed invention considered as a whole makes over the prior art. Once the special technical features of each invention have been identified, one must determine whether or not there is a technical relationship between the inventions and, furthermore, whether or not this relationship involves these special technical features. It is not necessary that the special technical features in each invention be the same. Rule 30(1) makes clear that the required relationship may be found between corresponding technical features. An example of this correspondence is the following: in one claim the special technical feature which provides resilience is a metal spring, whereas in another claim it is a block of rubber.”

Because the present patent application is filed under PCT, which is controlled by the “unity of invention” standard. This standard allows inventions with a single general inventive concept to be pursued in a single application, as long as each possesses the same special technical feature. Proteins which derive from the same gene, or which are otherwise related, would therefore be examined in a single patent application.

Paragraph [0090] of the present invention recites the following: “There were identified eleven structurally unrelated compound classes with primary amine substituents assumed to refer to the ATP binding sites of ATP binding proteins, like protein kinases, which have ideal properties for immobilization on solid support materials via the primary amines. These compound classes are the classes A to K represented by the general formulas I to XI described in detail above.”

It is then evident that the above quoted paragraph shows that there is a common “special technical feature”, namely the eleven compound classes with primary amine substituents have the ideal properties of immobilization on solid support materials via the primary amines.

Furthermore, regarding the Groups XII to XXII in the Office Action:

The following support is found in Paragraph [0086] of the present invention to attest to the presence of a common “special technical feature”:

[0086] According to another aspect, the present invention refers to a method for enriching, purifying or depleting at least one ATP binding protein, e.g. a protein kinase, from a pool of proteins containing at least one such ATP binding protein, the method comprising the following

steps (a) immobilizing at least one of the compounds of the compound classes A to K (compounds of the formulas I to XI) as described above on a support material, (b) bringing the pool of proteins containing at least one ATP binding protein into contact with at least one of the immobilized compounds of the compound classes A to K (compounds of the formulas I to XI), and (c) separating the proteins not bound to the at least one compound of the compound classes A to K (compounds of the formulas I to XI) immobilized on the support material from the at least one ATP binding protein bound to the compound of the compound classes A to K (compounds of the formulas I to XI) immobilized on the support material.

It is then evident that the above quoted paragraph shows that there is a common "special technical feature" (the underlined portion) for the above method, namely the steps (a), (b), and (c) that are commonly performed irregardless of which of the compound classes A to K (compounds of the formulas I to XI or at least one ATP binding protein are actually used.

Therefore, the same common "special technical feature" renders Groups XII to XXII to be of a single general inventive concept, and should be allowed to be included in the present application as well.

37 CFR 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage recites the following:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Thus, according to 37 CFR 1.475 (b)(3) above, it follows that it is quite permissible to have the following:

Groups I-XI: a product

Groups XII-XXII: use of said product

Groups XXIII-XXIV: process specially adapted for the manufacture of the said product

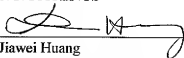
As a result, Groups I-XXIV should all be allowed to be included in the present application.

Regarding to the required election of a completely defined single general formula I-XI defined by that group, Applicants respectfully submit that a skilled artisan could deduce, based on chemical theories, the non-elected substituents of the general formula V according to the elected substituents, for example, represented by Compound G in Table I. A restriction to one thereof is thus not proper.

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